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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,020	12/26/2000	Koichi Awano	001740	3284

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/747,020	AWANO, KOICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>22 October 2004</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-4 are pending. Claims 1-4 have been amended in this communication filed 10/22/04 entered as Response After Non-Final Action.
2. The claim objection to claims 1, 3, and 4 has been overcome by Applicant's amendment to the claims and is hereby withdrawn for claims 1, 3, and 4. Claim 2 still remains objected to as set forth here below.
3. The Substitute Specification filed 10/22/04 has been reviewed and approved.
4. The 35 USC 112 second paragraph rejection for claims 3 and 4 has been overcome by Applicant's amendment to claim 3 and is hereby withdrawn.

### ***Claim Objections***

5. Claim 2 is objected to because of the following informalities: Claim 2, lines 2 and 3 reads "... wherein said prepaid card stores not an amount of money having a cash function but instead stores credit grant information indicative of a usable amount". This would be better read "... wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount". This Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3624

7. Claims 1- 4 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,003,762) Hayashida.

As per claim 1, Hayashida teaches, A card settlement system using a debit card comprising means for issuing a prepaid card by using a debit card having a money withdrawal function (col. 1, lines 14-16); means for transmitting settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued (col. 1, lines 61-67, col. 3, lines 15-58, and col. 4, lines 13-15); and means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data (col. 5, lines 51-61, col. 8, lines 56-67, and col. 9, lines 1-23).

As per claim 2, Hayashida teaches, The card settlement system according to Claim 1, wherein said prepaid card stores not an amount of money having a cash function but instead stores credit grant information indicative of a usable amount (col. 3, lines 50-57).

As per claim 3, Hayashida teaches, A card settlement system using a debit card including a reader and writer unit installed in a store, said reader and writer unit comprising: means for inputting or reading settlement data to be paid to said store by using a prepaid card storing credit grant information (col. 3, lines 62-67 and col. 4, lines 1-16); means for storing balance data obtained by subtracting said settlement data from said credit grant information or a balance previously obtained (Col. 14, lines 10-50 and

Fig. 12 (m12 & m19); and means for transmitting said settlement data to a settlement bank through a store's bank with which said store has an account (col. 15, lines 10-49).

As per claim 4, Hayashida teaches, A card settlement system using a debit card including an ATM of a settlement bank, said ATM comprising: means for issuing a prepaid card by using a debit card having a money withdrawal function (col. 3, lines 16-49); means for inserting a prepaid card having a balance and a cash card into said means for inputting an identification number (col. 12, lines 14-23 and fig. 9 (811)); and means for permitting withdrawal of money when said identification number is proper and for processing said prepaid card to an invalid state (col. 12, lines 27-46).

### ***Response to Arguments***

8. Applicant's arguments filed 10/22/04 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Hayashida fails to disclose a card settlement system using a debit card to issue a prepaid card, as recited in claims 1-4 of the instant application has been considered but is not persuasive. Response to argument: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a card settlement system using a debit card to issue a prepaid card") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is not interpreted from the claim language that a debit card is used to issue a prepaid card. It is well

Art Unit: 3624

known that in today's world of banking and business that a debit card with a limited amount can be used for purchases and merchant debits the customers bank account for payment of the merchandise.

In conclusion: The Applicant is respectfully requested to point out to the Examiner in the independent claim(s) the inventive concept of the invention.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

*During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<*

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3624


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Inquiries**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
E. Colbert  
January 8, 2005